UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,527	09/12/2003	Tetsuro Motoyama	241499US2CONT	5289

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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/660,527	MOTOYAMA ET AL.
	Examiner	Art Unit
	Prieto Beatriz	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
> THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
>   after SIX (6) MONTHS from the mailing date of this communication.
> - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
>   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
>   earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 November 2004*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　　1.☐ Certified copies of the priority documents have been received.

　　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date *11/04*.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is in response to Amendment filed 11/24/04, claims 1, 5, 7 and 9 have been amended, claims 13-15 have been added, thereby claims 1-15 remain pending.

2.   Acknowledge is made to Information Disclosure Statement (IDS) filed 11/04/04, considered, initialed and enclosed.

3.   Regarding the rejection of claim 1 under 35 U.S.C. §101 applicant's arguments have been considered, and not found persuasive. However, claim 1 portrays data structure defined structural and functional interrelationships between the data structure and the computer software and hardware component, which permit the data structure's functionality to be realized, and is thus statutory (see MPEP 2106). Rejection is withdrawn

4.   Regarding the rejection of claim 1 under judicially created doctrine of obviousness-type double patenting over the claims 1 and 6 of U.S. Patent No. 6,631,247 ('247) in view of U.S. Patent No. 5,935,262, applicant's traversal (p. 7 of remarks) has been considered. Applicant argues that the '247 patent does not disclose the step of "processing stored device information to generate a period usage report for a network device", as amended claim 1.

        In response to the above-mentioned argument, it is noted that non-statutory double patenting rejection of the obviousness-type applies to claims directed to the *same inventive concept with different appearances or differing scope, which are patentably indistinct from each other*. Nonstatutory categories of double patenting rejections,. which are not the "same invention" type, may be overcome by the submission of a terminal disclaimer. It is noted that "processing stored device information to generate a period usage report for a network device", as amended claim 1, does not make the inventive concept with different appearances or differing scope patentably distinct from each other. Argument is not persuasive the rejection is maintained.

5.   Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent '247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262. Although the conflicting claims are not identical, they

are not patentably distinct from each other because instant application is an obvious variation of the '247 patent.

Claim 1 of the application has substantially the same substance of claims 1 and 6 of the 247 patent. Both the application and '247 patent in substance transfer status information from a network device to a first computer and thereafter to a second computer. The difference between the application and the patent is that in the application a determination as to whether to transfer to the second computer is made, in instant application a report is periodically generated for transmission to a computer. The noted difference between the conflicting claims is not suffice to render the invention of claim 1 of the application patentably distinct and/or therefore substantially the same invention and/or a mere obvious variation of the patent '247.

Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer (col 2/lines 11-26), the information including status information (col 25/lines 47-55), the processing (e.g. retrieving and/or formatting) obtained status information to generate report *(col 16/lines 25-40, col 12/lines 28-38). It would have been obvious to one ordinary skilled in the art at the time the invention to periodically process and format status information for transmission to a computer by the device itself or by a computer as discussed by Barrett enabling the periodic transmission of status information base on predetermined condition such as when sufficient information is available or a memory capacity has been met, upon demand or in response to a predetermined time being met, set forth by Barrett.

In this case, the inventive concept of the patent '247 is the transmission of information from a network device (e.g. copier, printer) obtained from sensors thereof to a first computer, wherein the device related information is transmitted from the first to a second computer based on a determination on the first computer, further aspects/appearances are, that the information comprises usage information about the device and that the information comprises an email (clms 1-10). Processing stored device information to generate a period usage report for a network device, as amended on claim 1, does not make applicant's invention a distinct inventive concept or patentable distinct from patent '247, as argued.

6.   Regarding the rejection of claims 1 and 3 under judicially created doctrine of obviousness-type double patenting over the claim 1 of U.S. Patent No. 5,544,289 ('289) in view of U.S. Patent No. 5,935,262, applicant's traversal (p. 7-8 of remarks) has been considered. Applicant argues that the '289 patent does not disclose storing information obtained from sensors of a network device, and processing

stored device information to generate a period usage report, nor where the first computer is remote from the network device, as amended on claim 1.

In response to the above-mentioned argument, it is noted that non-statutory double patenting rejection of the obviousness-type applies to claims directed to the *same inventive concept with different appearances or differing scope, which are patentably indistinct from each other*. It is noted that "storing information obtained from sensors of a network device, and processing stored device information to generate a period usage report, nor where the first computer is remote from the network device, as amended on claim 1, does not make the inventive concept with different appearances or differing scope patentably distinct from each other. Argument is not persuasive the rejection is maintained.

In this case, the inventive concept of the patent '289 is the transmission of information ("semi-static data changeable over life") from a network device (copier, printer, etc.) to a first computer, wherein the device related information is transmitted from the first to a second computer, further aspects/appearances (clms 1-16) are, that the information is stored on the memory (ROM) of the device, the first computer is a "remote diagnostic computer", information comprises "semi-static and static data", i.e. changes and does not change over the life of the device. Processing stored device information to generate a period usage report, nor where the first computer is remote from the network device, as amended on claim 1, doesn't make applicant's invention a distinct inventive concept or patentable distinct from patent '289, as argued. Argument is not persuasive the rejection is maintained.

Claim Rejection under 35 U.S.C. 103

7.   Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

8.   Claim 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et. al. U.S. Patent No. 5,897,236 (Hashimoto hereafter) in view of Tarr et. al. U.S. Patent No. 5,184,179 (Tarr hereafter).

Regarding claims 1, 5 and 9, Hashimoto discloses features of the invention as claimed, including as shown in Fig. 4, a network device (1) communicatively coupled to a network, comprising:

obtaining by a first computer (18) status information of the network device (col 8/lines 66-col 9/line 4), including information obtained from sensors of the network device (col 8/lines 36-40),

information including usage information (col 9/lines 5-10, col 10/lines 51-54 and Figs. 14A and 14B) and including device identification (col 10/lines 20-31);

storing the obtained device status information at the first computer (col 1/lines 1-4, col 2/lines 1-9);

processing the stored status information to generate a collection of said information (called "usage report") for the network device, processing including selecting predetermine data (col 7/lines 40-57) for producing the remote report (col 10/lines 29-31), and updating stored information (see col 9/lines 26-67);

transmitting the usage report from the first computer to a second computer (col 9/lines 48-67); and

receiving the usage report by the second computer from the first computer (col 15/lines 60-63); however Hashimoto does not teach where the network device and the first computer communicate over a network.

Tarr teaches a first computer at a remote site from a network device obtaining information there from (col 9/lines 35-57), wherein the first computer communicated with the network device over a network (col 9/line 58-col 10/line 4), the first computer configured to generate report for transmitting to a second computer (col 11/lines 17-26), including processing (e.g. evaluating) received information for generating report for transmission (col 12/lines 11-54).

It would have been obvious to one ordinary skilled in the art at the time the invention was a made given the teachings for accessing status information from a network device for transmitting to a remote computer, the teachings of Tarr for obtaining status information from remote copiers would be readily apparent. Motivation would be to retrieve status information from a plurality of copiers using only an external telephone line.

Regarding claim 2, transmitting the usage report to the second computer at a predetermined time or upon the occurrence of a predetermined event (col 9/lines 14-59 and col 10, lines 5-19).

Regarding claim 3, the network device is a copier (Figs. 15A-B), and the usage report includes a number of copies made by the copier over a predetermined period (col 9/lines 7-18).

Regarding claims 6-7, these system claims are substantially the same as the method claims 2-3, discussed above, same rationale of rejection is applicable.

Regarding claims 10-11, these computer program product claims are substantially the same as the method claims 2-3 and the system claims 6-7, discussed above, same rationale of rejection is applicable.

9.   Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hashimoto in view Tarr in further view Danknick et. al. U.S. Patent No. 5,901,286 (Danknick hereafter)

Regarding claims 4, 8 and 12, however the Hashimoto reference does not teach the use of HTML or Excel formats in its usage reports;

Danknick discloses as prior art accessing a network device by a computer to obtain the network device's status information including converting the obtained status information to an HTML format (col 1/lines 45-48), furthermore teaching relocatable software executing on a computer configured to translate information regarding status information associated with usage in a network device into a HTML format for rendering as a web page (col 10/lines 30-36) or other formats (col 12/lines 42-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of Hashimoto for monitoring a network device by accessing its status information a including displaying the obtained data received via modem telephone based network to include supporting the access to network device status information via a telephone network, motivation would be to further enhance Hashimoto's system with existing technology such as high speed digital lines, e.g. high speed integrated digital network (ISDN) telephone lines enabling Web based monitoring functions as set forth by Danknick.

Regarding claims 13-15, report is generated on a monthly or weekly basis (Hashimoto: monthly basis col 9/lines 48-67, generating for transmission one a month col 15/lines 36-45).

10.   Claim 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Barrett et. al. U.S. Patent No. 5,935,262 (Barrett et. al).

Regarding claims 1, 5 and 9, Barrett discusses as prior art;

accessing a network device by a first computer to obtain device status information of the network device, including information obtained from detector or counter ("sensors") of the network device (col 1/lines 44-50), wherein the first computer is remote from the network device (col 1/lines 51-65), wherein the first computer obtains device information over a LAN (col 1/lines 40-50);

storing the obtained device status· information for further processing (col 1/lines 51-55); processing the stored status information to generate a ("usage report") collection of information for the network device (col 1/lines 51-55), processing formatting obtained information to generate report, col 16/lines 25-40, col 12/lines 28-38);

transmitting the usage report from the first computer to a second computer (e.g. remote PC) (col 1/lines 51-55); and receiving the usage report by the second computer (col 1/lines 51-55), although the collection of status information generated in the Barret's reference is not denoted "period usage report" it comprises the same features as claimed.

It would have been obvious to one ordinary skilled in the art at the time the invention was made to perform task periodically motivated by Barrett's disclosure for example, to periodically process the status information according to maintenance or billing cycle for which the status information is obtained and used for, as disclosed by Barrett.

11.   Applicant's arguments filed 11/24/04 have been fully considered but not rendered persuasive.

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beatriz Prieto whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained fro the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see http://pair-direct.uspto.gov or the Electronic Business Center at 866-217-9197 (toll-free).

B. Prieto
Patent Examiner
January 15, 2005